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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Worldwide Financial Services, Inc.**

Serial No. 75/048,341

Andrew R. Basile of Young & Basile for Worldwide Financial
Services, Inc.

Andrew A. Roppel, Trademark Examining Attorney, Law Office 108
(**David E. Shallant**, Managing Attorney).

Before **Seeherman, Hohein** and Wendel, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Worldwide Financial Services, Inc. has filed an
application to register the mark "WORLDWIDE SAYS YE\$\$, WHEN THE
BANKS SAY NO" for "mortgage and home equity loan services;
mortgage brokerage services; first and second mortgage lending;
equity financing; mortgage banking and real estate brokerage
services."¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 75/048,341, filed on January 25, 1996, which alleges a bona
fide intention to use the mark in commerce.

applicant's mark, when applied to its services, so resembles the mark "WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES," which is registered for "mortgage and home equity loan services,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

Turning first to consideration of the respective services, we observe that they are identical in part ("mortgage and home equity loan services") and are otherwise closely related. Indeed, applicant "acknowledges that some of the services it is providing appear to be the same as [those of] the Registrant." The Examining Attorney, moreover, points out that "the remainder of the applicant's services are closely related to the registrant's services because they all involve real estate finance and would therefore travel through similar trade channels and would be targeted to similar types of consumers." Applicant, we note, does not take issue with such contention. Consequently, if mortgage and home equity loan services, and other closely related real estate financial services, were to be offered under the same or substantially similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Considering, then, the respective marks, the Examining Attorney, citing *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980), relies upon

² Reg. No. 1,955,488, issued on February 13, 1996, which sets forth dates of first use of January 8, 1983.

the familiar principle that, "[i]f the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services." The Examining Attorney, while conceding that the marks "WORLDWIDE SAYS YE\$\$, WHEN THE BANKS SAY NO" and "WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES" obviously "have some optical and aural dissimilarity," contends that the marks in their entirety nevertheless "create the same commercial impression because they have the same meaning and connotation." Such similarity, the Examining Attorney insists, is sufficient to support a finding of a likelihood of confusion.

In particular, the Examining Attorney maintains that:

The meaning of the marks is created by the juxtaposition of two distinct phrases. One phrase is "we say yes" while the other phrase is "when the bank(s) say(s) no." It is these two phrases which are transposed in the respective marks. Regardless of the transposition, the meaning conveyed by each mark is identical, namely, that after one goes to a bank and they say no, one will get a yes from the service provider.

Thus, notwithstanding that applicant's mark contains both the word "WORLDWIDE" in place of the word "CHAMPION" and the stylized term "YE\$\$" instead of just the word "YES" alone, and that, in relation to providing mortgage and home equity loans, the notion of saying "yes" or "no" is a fairly common one, the Examining Attorney insists that:

The examining attorney does not assert that the common wording--"yes" and "no"--in the marks creates a similar commercial impression. The similarity goes beyond the commonality of these two words alone. The

marks convey the same general idea--the trademark [sic, should be service mark] identifies a source that will say "yes" (to your loan) when the bank (you asked) says "no." The marks stimulate the same mental reaction--the consumer will picture the bank's disapproval followed by the approval by the service provider. By the applicant's own admission, the "idea [conveyed by the marks] is [sic, may be] the same--someone loaning money when some[one] else will not."

In view thereof, and since, due to the purchasing public's fallibility of memory and consequent lack of perfect recall, the recollection retained by the average consumer is normally that of a general rather than a specific impression of service marks, the Examining Attorney argues that confusion is likely and that any doubt in this regard must be resolved in favor of the registrant. Furthermore, as indicated in the final refusal, the Examining Attorney urges in this regard that:

[Otherwise,] any applicant may simply substitute its tradename [sic] in the place of a registrant's tradename [sic], appropriating the remainder of the wording from the registrant's mark This would lead to the following possibilities: EVERYBODY NEED A LITTLE KFC and EVERYBODY NEEDS A LITTLE POPEYE'S; THIS BUD'S FOR YOU and THIS COORS['] FOR YOU; [and] AMERICAN EXPRESS: DON'T LEAVE HOME WITHOUT IT and VISA: DON'T LEAVE HOME WITHOUT IT.

Applicant, on the other hand, insists that confusion is not likely. Specifically, applicant asserts that while the Examining Attorney "admits [that] the marks have optical and aural dissimilarity," the Examining Attorney's analysis essentially "claims [that the] marks really are 'WE SAY YES, WHEN BANKS SAY NO,'" thereby "disregarding the distinguishing and unrelated other elements in the marks, namely that 'WE' is

'CHAMPION' in one and 'WORLDWIDE' in the other." As applicant points out:

These two terms have nothing in common and are clearly distinguishable from each other. No one would confuse these words.

Applicant, in consequence thereof, contends that when compared in their entireties, the respective marks look and sound very different; they are not merely transpositions of each other; and they are not so similar as to be likely to cause confusion since "[t]he overall commercial impression of these marks is not the same at all."

Moreover, while acknowledging that "[t]he idea may be the same--someone loaning money when some[one] else will not," applicant points out that:

The [respective] marks, however, clearly set forth who will be the grantor. In the mortgage and banking field, that is what every bank and mortgage company is doing--lending money in some capacity. Therefore, the purchasers are cognizant of the use of these terms in marks ("saying yes/no") and the marks containing these terms are not as strong. A unique term identifying a party distinguishes the mark from others. When a party is attempting to get a loan, saying "YES" and "NO" would be a fairly common thought to deal with and would not be viewed as source identifying. The terms "WORLDWIDE" or "CHAMPION" on the other hand would be.

In view thereof, and in light of the stylized presentation of the term "YE\$\$"--with double dollar signs--in its mark, applicant insists that "[i]t would not be reasonable for a purchaser to confuse these marks and believe that the same entity was the source for both services."

Lastly, with respect to the Examining Attorney's assertion in his final refusal that applicant has merely substituted its name "WORLDWIDE" for registrant's name "CHAMPION" in an effort to appropriate registrant's mark as its own, applicant urges that:

[T]his is not what is really taking place here. The example EVERYONE NEEDS A LITTLE POPEYE'S becomes unconfusing if it is POPEYE'S - EVERYONE NEEDS IT or FOR YOU - A COORS or HAVE VISA WHEN YOU LEAVE HOME. These marks are not now confusing to the original sayings and would not be likely to be associated as to source. Neither will the Applicant's mark, WORLDWIDE SAYS YE\$\$, WHEN THE BANKS SAY NO and [Registrant's mark,] WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES.

We are constrained to agree with applicant that, absent such considerations as a showing that registrant's mark is famous or at least well known, contemporaneous use of the respective marks, even in connection with the identical services of providing mortgage and home equity loans, is not likely to cause confusion. Irrespective of the double dollar sign stylization in the term "YE\$\$ in applicant's mark, which underscores the concept of an approval of a loan of money, the marks "WORLDWIDE SAYS YE\$\$, WHEN THE BANKS SAY NO" and "WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES" both convey the common, trite and highly suggestive notion of a finance or mortgage company being willing to lend money to less credit worthy customers than a commercial bank or banks would do. As applicant persuasively argues, when a consumer is attempting to secure a loan, whether from a bank or from a finance or mortgage company, the concept of being told "YES" or "NO" as an expression, respectively, of approval or

disapproval of the loan application is "a fairly common thought to deal with and would not be viewed as source identifying," as would be the fanciful, if not arbitrary, terms "WORLDWIDE" and "CHAMPION." Such terms, as is beyond dispute, individually have absolutely nothing in common, in terms of sound, appearance, connotation or commercial impression, with each other. When incorporated in the respective marks, such terms serve to distinguish those marks, when considered in their entireties, inasmuch as the primary source-identifying elements therein are the terms "WORLDWIDE" and "CHAMPION".

We also concur with applicant that this is not a case in which an applicant has usurped a registrant's slogan merely by substituting its trade name or mark for the registrant's trade name or mark. Here, although the notion suggested by both slogans is quite similar, the transposition of the phrases comprising such notion is sufficient, given the complete dissimilarity in the terms "WORLDWIDE" and "CHAMPION," to render the marks "WORLDWIDE SAYS YE\$\$, WHEN THE BANKS SAY NO" and "WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES" distinguishable on the whole. Mortgage and home equity loan services, along with such closely related services as mortgage banking, first and second mortgage lending, equity financing, and real estate brokerage services, are all services which are typically considered and purchased, even by ordinary consumers, with deliberation and the exercise of greater than average care, given the amount of money being lent and the equity or other assets being pledged to secure the transaction. Under such circumstances, borrowers are likely

to know the lender with whom they are dealing and would not be prone to being confused, as to the source or sponsorship of the respective services, by the marks at issue. Finally, even if applicant's mark "WORLDWIDE SAYS YE\$\$, WHEN THE BANKS SAY NO" may happen to bring to mind registrant's mark "WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES," or the general notion of approval by one loan provider after disapproval by another which is conveyed by that mark, such momentary association is not indicative that the public is likely to be confused by the respective marks, given the glaring difference in their source-identifying terms. See, e.g., Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) and In re P. Ferrero & C.S.p.A, 479 F.2d 1395, 178 USPQ 167, 168 (CCPA 1973).

Decision: The refusal under Section 2(d) is reversed.

E. J. Seeherman

G. D. Hohein

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board